

REMARKS

Applicants hereby add new claims 28-30. Accordingly, claims 1-30 are pending in the present application.

Claims 21-27 stand rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-4, 7-11, and 14-19 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,405,178 to Manchala in view of Office World News (OWN). Claims 5-6, 12-13, and 20 stand rejected under 35 USC 103(a) for obviousness over Manchala in view of Office World News. Claims 21-24 and 27 stand rejected under 35 USC 103(a) for obviousness over Manchala in view of Office World News. Claims 25 and 26 stand rejected under 35 USC 103(a) for obviousness over Manchala in view of Office World News.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Applicants hereby amend the specification to conform the specification to the drawings in accordance with MPEP 2163.06 (8th ed.) which provides that information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without adding new matter. MPEP §2163.06 (8th ed.) states it is well accepted that a satisfactory description may be in the claims or any other portion of the originally-filed specification and an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, **figures**, diagrams, and formulas that fully set forth the claimed invention (citations omitted). Applicants respectfully request withdrawal of the objection to the drawings in view of the conformance of the specification to the drawings.

Referring to the 101 rejection of claims 21-27, Applicants disagree with the non-statutory subject matter rejection. Claims 21-27 are a form of a propagated signal claim which has been widely recognized and accepted by the Office as patentable. For example, Applicants refer the Examiner to recently issued U.S. Patent Nos. 6,792,607; 6,791,971; 6,791,217; 6,789,108; 6,788,692; 6,788,681; 6,785,688; 6,785,609; 6,782,503; 6,779,114; 6,778,980; 6,778,653; 6,775,804; 6,775,581; 6,775,420; 6,774,987; 6,772,148 which also claim in varying forms propagated signal claims. This list is only exemplary and there are numerous other examples. In particular, Applicants refer the Examiner to U.S. Patent No. 6,785,609 issued August 31, 2004 which recites

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in claim 11 a Beauregard style program storage device claim and in claim 13 of the same patent a propagated signal style recitation claiming a data signal. Also, see U.S. Patent No. 6,775,581 issued August 10, 2004 which recites a storage medium Beauregard style claim in claim 47 and a propagated signal style claim as claim 62.

The Examiner's attempt to exclude Applicants from data signal protection is completely contrary to precedent established by the Office by the common practice of issuing propagated signal claims in numerous patents issued by the Office. To deny Applicants the same protections as afforded to other patentees is a violation of Applicant's rights under at least the equal protection clause of the 14th Amendment to the U.S. Constitution. Applicants respectfully submit that claims 21-27 are directed towards statutory subject matter as widely acknowledged by the Office by the issuance of numerous patents including propagated signal claims and Applicants request withdrawal of the 101 rejection of claims 21-27 for at least this and the above compelling reasons.

Referring to the obviousness rejections, and to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the *prior art reference (or references when combined) must teach or suggest all the claim limitations*. See, e.g., MPEP §2143 (8th ed.).

Referring to the 103 rejection of claim 1, the Office Action on page 5 states that Manchala fails to disclose or suggest a printer sending email. Thereafter, the Office relies upon the teachings of OWN to allegedly cure the deficiencies of Manchala. The combination of reference teachings is improper and the 103 rejection is improper for at least this reason.

As set forth by the Office, the printer of Manchala is not configured for email communications. In addition to the deficiencies identified in the Office Action and perhaps even more significant, *the printer of Manchala is additionally not configured to transmit an order for additional supplies of a consumable as positively claimed*. The ordering is only implemented by the network application which services a fleet of printers as set forth in col. 3, lines 30-35 of Manchala. It is clear that Manchala is directed towards an entire system approach for managing and purchasing consumables.

Manchala clearly provides an integrated system as set forth in col. 3, lines 20-25. More specifically, as positively set forth in col. 3, the system of Manchala provides a total solution for electronic commerce that is also tied to inventory management, email filtering, negotiation of price and rule based authorization to purchase goods including consumables. Accordingly, there is absolutely no motivation to modify Manchala to configure a printer to go around the total solution of the network application of Manchala to order consumables independently. The modification proposed by the Office is directly contrary to the disclosed total solution of Manchala and would destroy the total solution of Manchala wherein the network application provides a purchasing service and authorization service in addition to inventory management and price negotiation. As clearly set forth in col. 4, lines 16-26 of Manchala, the event-notification service of the network application consults the authorization service to determine quantity or cost of replaceable parts that the network application is permitted to order. It is stated that the event notification service communicates with the purchasing service and the purchasing service places an order with the vendor.

In summary, Manchala provides a total solution providing a network application that services a fleet of printers. The network application carefully considers inventory, price and authentication when ordering consumables and provides filtering to avoid spam. *There is no teaching or suggestion to burden individual printers of the fleet of Manchala with the capabilities already provided by the network application*. The only motivation results from improper reliance upon Applicants' disclosure. However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

In addition, the above-described aspects of the network application would be circumvented by configuring the individual printers to place their own orders without the inventory management, negotiation, authorization or authentication provided by the total solution of Manchala. In particular, configuring individual printers to place their own orders as alleged by the Office would not take into account the consulting of the inventory management system of the network application disclosed at col. 3, lines 30-36 or the negotiations of best price provided by the network application at col. 3, line 36. Accordingly, the total solution purpose of Manchala would be destroyed if

Manchala were modified as proposed by the Office and this further evidences the lack of motivation to support the 103 rejection. *See In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) (stating that a proposed modification is inappropriate for an obviousness inquiry when the modification renders the prior art inoperable for its intended purpose).

The Office on page 5 of the Action alleges that motivation is present "in order to provide cost effective printer service support capability and convenience for users." Applicants submit that the alleged motivation is insufficient and contrary to the total solution teachings of Manchala. Indeed, at col. 4, lines 20-24 the printers are already configured to send an event to the notification service of the network application which proceeds to perform analysis including checking inventory and performing authentication operations and then orders the consumables if appropriate after the best price has been negotiated. There is no disclosure that the communication of the event is deficient towards the purpose of Manchala or that any improvements are provided if the teachings are combined to enable the printers to communicate via email. Indeed, communications of individual printers would circumvent the price negotiating, spam filter, inventory management and authentication provided by the network application. Regardless, even if the printers are modified to provide email communications as disclosed by OWN, the combination still leaves the printer incapable of *transmitting an order for a consumable*.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fitch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated

that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are contrary to the reference teachings and are insufficient for proper motivation as set forth by the Federal Circuit. Further, the teachings of OWN are redundant to the teachings of Manchala in view of the already disclosed capabilities of the printers of the fleet to communicate events to the notification service and one would not be motivated to combine the reference teachings in view of the redundancy. Why would one aware of the teachings of Manchala look to OWN for teachings directed to the subject matter already disclosed in Manchala? The answer in view of the lack of any supporting objective evidence is the motivation can only result from improper reliance upon Applicants' disclosure. The 103 rejection is improper for at least this reason.

Even if combined, the combination of reference teachings fails to disclose or suggest the claimed transmission of the email from the peripheral device to order additional supplies of the consumable. OWN cited by the Office merely discloses that technicians may access Internet-enabled copiers and printers for remote access to product information, device configuration, service and support. Dealers may monitor usage of consumables. It is stated on page 2 of 3 of OWN that the technician may program the printer to send early warning notifications for consumables replenishment via page or email. The communication of warning notifications fails to disclose or suggest the claimed communication of an order. In fact, OWN is void of any disclosure or suggestion of a printer or copier communicating an order. Accordingly, even if the teachings are combined, the combination fails to establish a prima facie 103 rejection for the above-recited numerous reasons and claim 1 is allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 7 recites that the transmitting comprises transmitting the email for the order of additional supplies of the consumable from the peripheral device

to a vendor web site. Manchala clearly discloses communicating an event to the network application and OWN merely discloses communicating a *notification* for consumables replenishment to save dealer costs. The prior art taken alone or in combination fails to disclose or suggest *a peripheral device transmitting an email including an order to a vendor web site as claimed*. Any modification of Manchala to arrive at Applicants' claim 7 invention is contrary to the Manchala total solution teachings regarding the network application including at least checking inventory and management, negotiating price, filtering spam email, and performing authorization and authentication. Claim 7 is allowable for this additional reason. Further, even if combined, the prior art teachings fail to disclose or suggest transmitting an email from a peripheral device to a vendor web site as claimed. Claim 7 is allowable for this additional reason.

Referring to claim 8, the rejection under 103 over Manchala and OWN is improper for numerous reasons. In particular, the Office has failed to establish a prima facie 103 rejection and claim 8 is allowable. Claim 8 positively recites that the article of manufacture comprises a computer usable medium having code configured to cause a processor contained in a peripheral device to transmit an email from the peripheral device to order additional supplies of the consumable associated with the peripheral device. Manchala is directed towards a total solution including a network application for servicing a fleet of printers. There is no motivation to modify a printer of Manchala to transmit emails to place an order contrary to the operations of the network application which checks inventory, negotiates price, and authenticates authorized vendors to place orders. The motivation alleged by the Office in the Action is contrary to the Federal Circuit precedent recited above. The Office has failed to establish a prima facie 103 rejection for at least this reason. In addition, even if the teachings of OWN regarding a printer notifying of consumables replenishment are combined with the teachings of Manchala, the combination fails to disclose or suggest limitations of claim 8. More specifically, the prior art, taken alone or in combination, fails to disclose or suggest the processor of the peripheral device transmitting an email from the peripheral device to order supplies and the Office has failed to establish a prima facie rejection of claim 8 for this additional reason. Applicants respectfully request allowance of claim 8 in the next Action for at least the above-recited compelling reasons.

The claims which depend from independent claim 8 are in condition for

allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, the Office has failed to establish a prima facie 103 rejection and claim 15 is allowable. The computer implemented control system for a hard copy output engine of claim 15 recites that the processing circuitry of the hard copy output engine transmits an email from the peripheral device to order additional supplies of the consumable associated with the peripheral device. Manchala is directed towards a total solution including a network application for servicing a fleet of printers.

There is no motivation to modify a printer of Manchala to transmit emails to place an order contrary to the operations of the network application which checks inventory, negotiates price and authenticates authorized vendors to place orders. The motivation alleged by the Office in the Action is contrary to the Federal Circuit precedent recited above. The Office has failed to establish a prima facie 103 rejection for at least this reason. In addition, even if the teachings of OWN regarding a printer notifying of consumables replenishment are combined with the teachings of Manchala, the combination fails to disclose or suggest limitations of claim 15. More specifically, the prior art, taken alone or in combination, fails to disclose or suggest the processing circuitry of the peripheral device control system transmitting an email from the peripheral device to order supplies and the Office has failed to establish a prima facie rejection of claim 15 for this additional reason. Applicants respectfully request allowance of claim 15 in the next Action for at least the above-recited compelling reasons.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, the prior fails to disclose or suggest the claimed computer instruction signal carrying instructions that cause a processor to transmit an email from the peripheral device to order additional supplies of the consumable associated with the peripheral device. There is no motivation to combine the prior art references of Manchala and OWN and the motivation alleged by the Office in the Action is contrary to the Federal Circuit precedent recited above. The Office has failed to establish a prima

facie 103 rejection for at least this reason. In addition, even if the teachings of OWN regarding a printer notifying of consumables replenishment are combined with the teachings of Manchala, the combination fails to disclose or suggest limitations of claim 21. More specifically, the prior art, taken alone or in combination, fails to disclose or suggest the instructions that cause the processor to transmit an email from the peripheral device to order supplies and the Office has failed to establish a prima facie rejection of claim 21 for this additional reason. Applicants respectfully request allowance of claim 21 in the next Action for at least the above-recited compelling reasons.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

As discussed above, even if the reference teachings are combined (which is improper for at least the above-recited reasons) the combination fails to disclose or suggest any *transmission of an email from a peripheral device to order additional supplies of a consumable associated with a peripheral device*. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification in a non-final action of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

Support for the new claims is provided at least at Fig. 1 and the associated teachings of the specification including pages 3-7. Allowance of the new claims is respectfully requested.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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